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EXAMINER

JUSKA, C

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

10/08/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/023,893

Applicant(s)

Beiser et al.

Examiner

Cheryl Juska

Group Art Unit

1771

☒ Responsive to communication(s) filed on Aug 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) 7, 8, 13, and 14 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6 and 9-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6 and 9-12, drawn to a carpet, classified in class 428, subclass 95.
  - II. Claims 7, 8, 13, and 14, drawn to a method of making a carpet, classified in class 427, subclasses 412 and 299+.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed could be made by forming a two-layer film and then laminating said film to the primary backing. Additionally, said product can be made without a pretreatment of the surface of the primary backing.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Osborne McKinney on September 24, 1999, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6

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and 9-12. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 7, 8, 13, and 14 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are drawn to "the carpet of claim 1 or the method of claim 7." Thus, said claims are indefinite for being drawn to more than one class of statutory subject matter. It is unclear if the limitations contained in claims 10-12 are article or method limitations.

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***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-6 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,741,594 issued to Jialanella.

Jialanella discloses a laminate and adhesive comprising a substantially linear ethylene polymer, such as that taught in US Patent 5,272,236 issued to Lai et al. (It is noted that Applicant teaches the Lai polymer in the specification, page 17, lines 1-6). The invention of Jialanella is taught to be useful as 'carpet-backing' (abstract and col. 5, lines 46-48). Although Jialanella does not explicitly teach Applicant's limitation of a carpet face of fibers, said limitation is deemed inherent to a carpet having a 'carpet-backing.' Therefore, said claims are anticipated by the cited Jialanella patent.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Jialanella patent.

Although Jialanella does not teach the fiber polymer, it is well known in the art of carpeting to employ polyolefins, specifically, polypropylene or polyethylene, as face fibers. Additionally, Applicant is given Official Notice that recyclable polyolefin carpets are well known in the art. Thus, it would have been obvious to one skilled in the art to choose a polyolefin face fiber in the invention of Jialanella, with the intention of enhancing the recyclability of the carpet.


Furthermore, Applicant is given Official Notice that labels and or literature are included with all carpets for sale in the United States. Applicant's limitation to the 'representation' of the label or literature is not given patentable weight because the words or symbols written on said label or literature are not structural limitations of the claimed article.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached at (703) 308-2414. Fax numbers for this Group are (703) 305-3601 and (703) 305-7718.

cj 

September 30, 1999

  
**TERREL MORRIS**  
**PRIMARY EXAMINER**  
**GROUP 1500**  
*1700*